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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/136,820	08/19/1998	ISTVAN SIMON	98-370	2191

7590 08/06/2002

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EXAMINER

PONOMARENKO, NICHOLAS

ART UNIT PAPER NUMBER

2834

DATE MAILED: 08/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 27

Application Number: 09/136,820
Filing Date: August 19, 1998
Appellant(s): SIMON, ISTVAN

ISTVAN SIMON
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on May 07, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because applicant makes a statement that his invention is operable, which is not correct, as disputed by the examiner in section **(11) *Response to Argument*** below.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Specification

1. The abstract of the disclosure is objected to because it is describing a device capable to "reuse" the energy of the downward movement of the water, i.e. makes an attempt to disclose a "perpetual motion" machine. Correction is required. See MPEP § 608.01(b).

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
- (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it fails to disclose a device that is functional or capable to operate, which means -- the specification is not enabling. Specifically, the disclosure fails to provide any structure or features that will support the newly amended statements, such as "...upward and downward movement of the cascade assembly is afforded by overfilling of a cascade assembly in relation to the other (with water from a flowing water source...."

The specification does not contain a written description of the invention with specific details on how to make or use the invention, in full, clear, concise, and exact terms as to enable a person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and the specification does not set forth the best mode contemplated by the inventor of carrying out his invention.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims **1-19** are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

Doctrine or principle of the conservation of energy.

If the boundary considered includes the universe, the principle of the conservation of energy amounts to a statement that the sum total of the energy of the universe is a fixed unalterable quantity.

The principle of the conservation of energy also denies the possibility of "perpetual motion." By "perpetual motion" is meant the devising of some arrangement so that energy in one form can be produced without energy in some other form being used up by the machine. Thus if an engine could be made to do work on external bodies for an indefinite time, and thus give out energy, without being supplied with energy from without, or diminishing the stock of energy in all its various forms which it originally possessed, we should have a means of creating energy, and this is in direct contradiction to the principle of the conservation of energy.

5. When a patent applicant presents an application describing an invention that contradicts known scientific principles, or relies on previously undiscovered scientific phenomenon, the burden is on the examiner simply to point out this fact to the appellant... The burden shifts to appellant to demonstrate either that his invention, as

claimed, is operable or does not violate basic scientific principles, or that those basic scientific principles are incorrect. *As stated by the Patent Office Board of Appeals, Newman v. Quigg 681 F.Supp 16, at18, 5 U.S.P.Q. 2d 1880(1988).*

Applicant is required to furnish a working model of his invention in order to demonstrate its operability. See MPEP § 608.03.

This rejection is set forth in prior Office Action, Paper No. 21.

(11) Response to Argument

Applicant's system is inoperative and therefore lacks utility, because the system as disclosed and claimed is an enclosed system, which means it utilizes its own internal structural architecture to generate energy, without any outside input of energy. These systems are known as "perpetual motion" machines. Applicant argued the issue of "perpetual motion" machine structural architecture, as described in examiner's final rejection, by merely only ONE statement in the specification (paragraph bridging Pages 12 and 13), which, according to the applicant, provides enough support and sufficient answer to the question of the source of the outside energy for system operability. Assuming that such external source of water is provided (which is not clearly disclosed), applicant additionally failed to demonstrate that structural features of the claimed invention are designed to be able to accept the outside source of energy in the form of, as stated, "water from a flowing source such as, for example, a waterfall...". The claimed and disclosed system is designed for "reuse" of the same water in the enclosed

system, again and again, and has no provisions for any outside water to be accepted into the system, or (if such outside water be provided) be able to utilize it for energy production. The disclosed structural details of the claimed system are designed and work as follows:

1. Water is lifted by the “lifter” (see Fig. 9), which is called “energy input means” in claim 1, from the water container 73.

2. When water is lifted to the top, it is spilled into container 43 (Fig.4, or 130 on Fig.6 in different embodiment) of the “motor”, which is called “a drive means” in claim 1.

3. The water is traveling from one container to another of the “motor”, and creates reciprocating movements, which are translated into rotational movement of the shaft by the system of levers and the float 26.

4. The “motor’s” water reaches the second container 25, from which it is spilled into the first container 73 through the trough 44 (Fig.1 and 4).

5. From the first container 73 the “lifter” takes the water and lifts it up for the cycle to be repeated.

It is obvious to one of ordinary skill in the art that applicant arguments about “water from a flowing source such as, for example, a waterfall” do not have place in the provided structure, or intended to be realized for two reasons:

1. The source of water for the “motor” is clearly provided by the “lifter” (not the “waterfall”) by utilizing the same water, which was used by the “motor”.

2. If the outside source of water could have been provided to the container 43 (or 130 in another embodiment) it would be in conflict with existing water source from the

"lifter" and water would not have any place to go since no provisions for the "drain" of the excess water either provided or disclosed, or claimed, and "water drain" features are clearly are not part of the applicant system, and/or arguments. Applicant failed to demonstrate or disclose that his system utilizes any external source of water or even "intends" to have such utilization. Applicant disclosed and claimed the enclosed system that reuses the same water to generate power, as in "perpetual motion" machine.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/136,820
Art Unit: 2834

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Respectfully submitted,




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Primary Examiner
Technology Center 2800

Appeal Conference held on June 13, 2002

Panel Participants:

Nestor Ramirez 

Arthur Grimley 

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June 18, 2002

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